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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,672	02/01/2002	Adam J. Koffler	1499.001US1	4553
21186	7590	03/25/2004	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.			FOELAK, MORTON	
P.O. BOX 2938			ART UNIT	PAPER NUMBER
MINNEAPOLIS, MN 55402			1711	

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/061,672

Applicant(s)

KOFFLER ET AL.

Examiner

Morton Foelak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-97 is/are pending in the application.
- 4a) Of the above claim(s) 66-97 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

**1. Restriction to one of the following inventions is required under 35**

**U.S.C. 121:**

**I. Claims 1-65 , drawn to a foam cushion, classified in class 521, subclass 134.**

**II. Claims 66-96, drawn to a method of making a foamed cushion, classified in class 264 or 156, subclass 50+.**

**Claim 97 is a nonstatutory claim and cannot be classified. Note claim 95 is recited after claim 96 and should be deleted since claim 95 does appear after claim 94.**

**The inventions are distinct, each from the other because of the following reasons:**

**2. Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant**

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**case, the intermediate product is deemed to be useful as insulation and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.**

**3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.**

**4. During a telephone conversation with Mr. Gary A. Speier on March 22, 2004 a provisional election was made with traverse to prosecute the invention of Group I claims 1-65 Affirmation of this election must be made by applicant in replying to this Office action.**

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**Claims 66-97 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.**

**5. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).**

***Claim Rejections - 35 USC § 103***

**6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

**(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.**

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- 7. Claims 1-55 are rejected under 35 U.S.C. 103(a) as obvious over Kozma et al '137, '503 or '928, alone, or in view of Roland et al '475, '962 or Briston.**
- 8. The primary references and for example '928, discloses a foamed cushion or flexible foamed article ((col. 1 second par., col. 16 line 12-31, TABLE I (compression deflection) and col. 26 lines 20-25)) from a blend of a rubber and a resin( both found in col. 7 to col. 10 and the blends in the working examples) , blowing agent (col. 12 line 55 et seq.), a polymeric adhesion modifier (as claimed , namely FUSABOND in col. 11 line 25 et. seq.), a decomposition accelerating agent, namely zinc oxide (note the working examples), a cross-linking agent (Col. 13 line 19 to col. 14 line41).**
- 9. The patentees also teach extrusion, foaming and cross-linking of these compositions(col. 14 lines 42 to 52).**
- 10. The secondary references are cited to teach that the zinc oxide employed in the working examples in the references acts as a decomposition accelerating agent or kicker.**

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**11. It appears the foamed cushion of the instant claims are met by the Kozma et al since even though the claimed product is made in three steps and the references are making it in two steps. Note that the cross-linking agent only begins to react with the other ingredients in the composition when the entire composition is heated.**

**12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:**

- 1. Determining the scope and contents of the prior art.**
- 2. Ascertaining the differences between the prior art and the claims at issue.**
- 3. Resolving the level of ordinary skill in the pertinent art.**
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.**

***Claim Rejections - 35 USC § 112***

**13. The following is a quotation of the first paragraph of 35 U.S.C.**

**112:**

**The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.**

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**14. Claims 39, 40, 58, 64 and 65 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The trade-marked terms "FUSABOND" AND "CELLPASTE" are not allowed to appear in the instant claims since they always subject to change without notice to the public. Since these trade marks have not attained a generic state it is requested that applicants insert the chemical identification of these terms plus documentation that their chemical identification was known prior to filing of the instant application.**

**Any inquiry concerning this communication or earlier communications from the examiner should be directed to Morton Foelak whose telephone number is (571) 272-1071. The examiner can normally be reached on Monday thru Friday.**

**If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)**

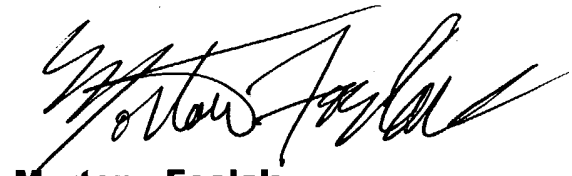


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**272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.**

**Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).**

**M.F.  
March 22, 2004**

  
**Morton Foelak  
Primary Examiner  
Art Unit 1711**